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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,523

11/14/2003

Gilles Houle

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EXAMINER

LU, TOM Y

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

02/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,523

Applicant(s)

HOULE ET AL.

Examiner

Tom Y. Lu

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1093-1147 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1093-1147 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12/13/2004 has been considered by the examiner.
2. The information disclosure statement (IDS) submitted on 12/23/2004 has been considered by the examiner.
3. The information disclosure statement (IDS) submitted on 05/21/2007 has been considered by the examiner.
4. The information disclosure statement (IDS) submitted on 09/19/2007 has been considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1109, 1126, 1129 and 1146 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

- a. Claim 1109 defines a carrier medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" –

Guidelines Annex IV). That is, the scope of the presently claimed a carrier medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

- b. Claims 1126, 1129 and 1146 are rejected for the same reason given in claim 1109.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 6. Claims 1093-1147 are rejected under 35 U.S.C. 102(b) as being anticipated by Stolfo (U.S. Patent No. 5,748,780).

- a. As per claim 1093, Stolfo discloses a method of assessing the validity of a payment instrument using a computer system (see figures 1 and 2), comprising: providing the payment instrument (check, column 11, line 16) to a computer system (figure 2), wherein the payment instrument comprises pre-printed information (column 11, lines 21); comparing at least a portion of the pre-printed information of the payment instrument to

at least one pre-printed profile representation derived from at least one other payment instrument (column 10, lines 21-40), wherein evidence of non-validity of the payment instrument comprises failure of at least a portion of the pre-printed of the payment instrument to approximately match at least one pre-printed representation (column 12, lines 4-21 and column 22, lines 19-40).

- b. As per claim 1094, Stolfo discloses wherein the payment instrument is a check (column 11, line 16).
- c. As per claim 1095, Stolfo discloses wherein the payment instrument is a giro (column 12, lines 26-28).
- d. As per claim 1096, Stolfo discloses wherein providing the payment instrument to the computer system comprises providing one or more images of the payment instrument to the computer system (column 11, lines 15-19).
- e. As per claim 1097, Stolfo discloses wherein providing the payment instrument to the computer system comprises providing one or more images of at least a portion of the pre-printed information of the payment instrument to the computer system. (column 11, lines 15-19 and see figure 3 for pre-printed information of a check)
- f. As per claim 1098, Stolfo discloses wherein the pre-printed information comprises pre-printed words, pre-printed characters, pre-printed graphic elements or combination thereof (see figure 3).

- g. As per claim 1099, Stolfo discloses wherein the pre-printed information comprises an account number, an account holder name, an account holder address, a bank name, a routing number, a payee name, a date, a courtesy amount, a legal amount a memo, or combination thereof (see figure 3).
- h. As per claim 1100, Stolfo discloses wherein at least one pre-printed profile representation comprises images of pre-printed graphic elements, pre-printed words, pre-printed characters, or combination thereof (the templates in the codebook database are also check images, which contains the claimed pre-printed information).
- i. As per claim 1101, Stolfo discloses wherein at least one pre-printed profile representation is derive from at least two information fields of at least one other payment instrument (the template check images in the codebook database are the claimed other payment instrument, which contains at least two information fields as shown in figure 3).
- j. As per claim 1102, Stolfo discloses wherein at least one pre-printed profiled representation is obtained from a validated payment instrument (template check images in codebook database are validated and used as reference images).
- k. As per claim 1103, Stolfo discloses comparing handwriting in one or more amount fields of the payment instrument to one or more writing profile representation derived from at least one other payment instrument, wherein evidence of non-validity of the payment instrument further comprises failure of at least a portion of the handwriting in at least one of

the amount fields of the payment instrument to approximately match at least one writing profile representation (column 15, lines 60-67 and column 16, lines 1-10, see figure 4, numerals 84 and 90).

- l. As per claim 1104, Stolfo discloses wherein one of the amount fields is a courtesy amount field (column 22, lines 49-50).
- m. As per claim 1105, Stolfo discloses wherein at least one of the amount fields is a legal amount field (column 22, lines 49-50).
- n. As per claim 1106, Stolfo discloses comparing handwriting in a signature field of the payment instrument is to one or more writing profile representations derived from at least one other payment instrument, wherein evidence of non-validity of the payment instrument further comprises failure of at least a portion of the handwriting in at least one of the signature fields of the payment instrument to approximately match at least one writing profiled representation (see numerals 84, 86 and 88 in figure 4).
- o. As per claim 1107, Stolfo discloses comparing handwriting in one or more information fields of the payment instrument to one or more writing profile representations derived from at least one other payment instrument, wherein evidence of non-validity of the payment instrument further comprises failure of at least a portion of the handwriting in at least one of the information fields of the payment instrument to approximately match at least one writing profiled representation (see numerals 84, 86 and 88 in figure 4).

- p. As per claim 1108, Stolfo discloses a system comprising: a CPU (column 11, line 19); a data memory coupled to the CPU (column 11, line 19); and a system memory (column 13, line 15; column 16, lines 12-22) coupled to the CPU, wherein the system memory is configured to store one or more computer programs executed by the CPU, and wherein at least one of the computer programs are executable to implement a method of assessing the validity of a payment instrument, the method comprising: providing the payment instrument (check, column 11, line 16) to a computer system (figure 2), wherein the payment instrument comprises pre-printed information (column 11, lines 21); comparing at least a portion of the pre-printed information of the payment instrument to at least one pre-printed profile representation derived from at least one other payment instrument (column 10, lines 21-40), wherein evidence of non-validity of the payment instrument comprises failure of at least a portion of the pre-printed of the payment instrument to approximately match at least one pre-printed representation (column 12, lines 4-21 and column 22, lines 19-40).
- q. As per claim 1109, for the claimed "carrier medium" see column 16, lines 12-21, and the rest of limitations are explained in claim 1.
- r. Claims 1110-1147 are similarly analyzed.

Conclusion

7. **Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although

the specified citations are representative of the teaching for the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potential teaching all or part of the claimed invention, as well as the context of the a passage as taught by the prior art or disclosed by the examiner.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y. Lu whose telephone number is (571) 272-7393. The examiner can normally be reached on 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571)-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/13/04;
12/23/04; 05/21/07; 09/19/07 .